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OFFICE OF PETITIONS

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

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| In re Patent of Gack et al. | : | DECISION ON REQUEST |
| Patent No. 7,842,464 | : | FOR RECONSIDERATION OF |
| Issue Date: November 30, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/576,266 | : | AND NOTICE OF INTENT TO |
| Filing Date: December 20, 2006 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. 097147-0106 | : | CORRECTION |

This is a decision on the petition filed January 31, 2011, which is being treated as a petition under 37 C.F.R. § 1.705(d). Patentees request that the patent term adjustment indicated in the patent be corrected from five hundred sixteen (516) days to seven hundred thirty-five (735) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted to to seven hundred thirty-five (735) is **granted to the extent indicated herein**.

On November 30, 2010, the above-identified application matured into U.S. Patent No.7,842,464. The instant request for reconsideration filed January 31, 2011 (a Monday) was timely filed within 2 months of the date the patent issued. See § 1.705(d). The patent issued with a revised Patent Term Adjustment of 516 days.

Patentees assert the correct patent term calculation is 231 days of A Delay + 592 days of B Delay – 88 days of Applicant Delay, which equals 735 days.

As a preliminary matter, patentees are correct that the maximum period of B Delay is 592 days. The period is measured beginning on April 18, 2009, the day after three years after commencement, and ending on November 30, 2010, the date of issuance of the patent. The Office incorrectly calculated the period as 593 days.

Patentees argue the Office improperly excluded the 220-day period from the period of B Delay.

*If* the Office's exclusion of the 220-day time period was improper, the Office would agree the patent term adjustment should be 735 days. However, patentees have failed to establish the exclusion of the 220-day time period was improper.

Pursuant to 35 U.S.C. § 154(b)(1)(B)(ii), B Delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." Patentees argue the period of appellate review does not begin until jurisdiction is transferred to the Board of Patent Appeals and Interferences ("Board") pursuant to 37 C.F.R. § 41.35.

The provisions of 37 C.F.R. § 1.703(b)(4) implement 35 U.S.C. § 154(b)(1)(B)(ii). Pursuant to 37 C.F.R. § 1.703(b)(4), the period of B Delay does not include,

> The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

The petition asserts 37 C.F.R. § 1.703(b)(4) excludes too many days because the filing of a notice of appeal does not commence the time period of appellate review by the Board.

Although the petition asserts the period of appellate review begins when jurisdiction is transferred to the Board, the petition fails to cite any court decision or legislative history to support such an assertion.

The Office has considered the arguments in the petition and concluded the phrase "time consumed by appellate review by the Board" in 35 U.S.C. § 154(b)(1)(B)(ii) begins when a notice of appeal is filed.

The phrase "appellate review by the Board" appears twice in 35 U.S.C. § 154(b). The fact the identical phrase is used in another location in the same statute is relevant because "identical words used in different parts of the same statute are ... presumed to have the same meaning." *IBP, Inc. v. Alvarez*, 546 U.S. 21, 34 (2005).

Pursuant to 35 U.S.C. § 154(b)(1)(C)(iii), successful "appellate review by the Board" will result in an adjustment for delay resulting from the appeal. The Office has interpreted 35 U.S.C. § 154(b)(1)(C)(iii) to provide for an adjustment based on delay beginning when a notice of appeal has been filed. 37 C.F.R. § 1.703(e) states, with emphasis added,

> The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period *beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed* under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

The Office's interpretation of 35 U.S.C. § 154(b)(1)(C)(iii) is supported by language in 35 U.S.C. § 154(b) prior to passage of the Patent Term Guarantee Act of 1999, Pub. L. No. 106-

113, § 4402, 113 Stat. 1501A-557. Prior to passage of the Patent Term Guarantee Act of 1999, 35 U.S.C. §§ 154(b)(2)-(3) stated, with emphasis added,

> Extension for *appellate review*. If the issue of a patent is delayed due to *appellate review* by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years....
>
> The period of extension ... shall include any period *beginning on the date on which an appeal is filed under section 134 or 141 of this title*, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant.

As shown by the language quoted above, the period of appellate review in the former version of 35 U.S.C. § 154(b) began when a notice of appeal was filed. When Congress passed the Patent Term Guarantee Act of 1999, Congress failed to take any action to indicate Congress wished to change the starting date for the period of "appellate review" from the date a notice of appeal is filed until the date the application file is transferred to the Board.

In view of the prior discussion, the Office has reasonably concluded the period of "appellate review by the Board" under 35 U.S.C. § 154(b)(1)(C)(iii) begins when a notice of appeal is filed. Since identical words or phrases in the same statute are presumed to have the same meaning, the Office asserts the period of "appellate review" under 35 U.S.C. § 154(b)(1)(B)(ii) also begins when a notice of appeal is filed. The Office recognizes the presumption the same word or phrase in a statue has the same meaning is rebuttable. *See Envtl. Def. v. Duke Energy Corp.*, 549 U.S. 561, 575-76 (2007). However, the context of each instance of the phrase in the statute at issue fails to clearly indicate Congress intended for the same phrase to have two different meanings.

The Office has considered the arguments in the petition and determined the petition fails to establish the provisions of 37 C.F.R. § 1.702(b)(4) are inconsistent with the provisions of 35 U.S.C. § 154(b)(1)(B)(ii). Pursuant to 37 C.F.R. § 1.702(b)(4), the time period excluded from delay under 37 C.F.R. § 1.702(b) begins when a notice of appeal is filed. In other words, the appellate review period excluded from the period of B Delay begins when a notice of appeal is filed.

In this case, the period of appellate review began when a notice of appeal was filed on December 16, 2009, and ended on July 23, 2010, when the Office mailed a Notice of Allowance. The time consumed by the period of appellate review was 220 days. Therefore, the Office properly excluded 220 days from the period of B Delay as a result of time consumed by appellate review.

In light thererof, the patent term adjustment is 515 days, which is 231 days of A Delay + 592 days of B Delay – 220 days of excluded appellate period – 88 days of Applicant Delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an

opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). This fee is required and will not be refunded. No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **five hundred fifteen (515)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,842,464 B2

DATED : **November 30, 2010** **DRAFT**

INVENTOR(S) : Gack et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 516 days

Delete the phrase "by 516 days" and insert – by 515 days--